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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PORTER, RACHEL L	

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/811,769	OSCAR ET AL.	
	Examiner	Art Unit	
	RACHEL L. PORTER	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-55* is/are pending in the application.

4a) Of the above claim(s) *1-13,19-22,32-35 and 40-48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-18 23-31,36-39, and 49-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to Appeal Brief filed 9/3/08. Claims 1-55 are currently pending. Claims 1-13, 19-22, 32-35, and 40-48 are withdrawn from further consideration as per applicant's response to the restriction requirement. Claims 14-18,23-31, 36-39 and 49-55 are rejected.

2. In view of the supplemental appeal brief filed on 12/9/08, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Drawings

3. The drawings are objected to because the poor contrast and small font in Figures 9-21 renders the text illegible . Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-31, 36-39, and 49-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to a machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr,* 450 U.S. 175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409 U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and should be rejected as being directed to nonstatutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

With respect to claim 27, the current provides only a nominal recitation of an apparatus server as a source of data (e.g. data storage) and is therefore non-statutory. Claims 28-31, 36-39, and 49-52 contain similar deficiencies and fail to correct the

deficiencies of claim 27, and are therefore also rejected.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 14-18, 23-31; 36-39; and 49-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 14, and, 27 recite limitations that are new matter, and are therefore rejected. The respective dependent claims inherit the deficiency through dependency and are therefore also rejected.

The added material which is not supported by the original disclosure is as follows:

- Calculat[ing] out-of-pocket costs sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information;

In particular, the Examiner able to find, any support for this newly added claim language within the specification as originally filed. As such, the Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims, or to cancel the new matter in the reply to this Office Action.

It is noted that the applicant has submitted citations to argue support for the newly added subject matter. However, the Examiner was still unable to find a description of the calculation of the recited data by any particular system component. Claims 15-18; 23-26; 27-31; 36-39; 49-52; and 53-55 inherit the deficiencies of claims 14 and 27 through dependency, and are therefore also rejected.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15-18, 23-26 and 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim element "management means…calculates-out of-pocket costs, sponsor costs…" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. In particular, it is not clear that the management means or any particular

component, calculates out-of-pocket costs sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. (see 112,1st paragraph rejection).

Claims 15-18; 23-26; and 53-55 inherit the deficiencies of claims 14 and 27 through dependency, and are therefore also rejected.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 14-18, 23-31, 36-39, and 49-55 are rejected under 35 U.S.C. 103(a) as being obvious over Pack-Harris (USPN 6,195,612) in view of Mayaud (USPN 5,845,255), and in further view of Lencki et al (US 2002/0049617)

[claim 14] Pack-Harris discloses a pharmacy benefits management system comprising:

- pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; (col. 3, lines 10-34)
- management means for receiving pharmacy benefits price information relating to drugs in various classes;
- provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information stored therein to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan;
- said management means further:
    - calculates total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information; (Figures 18-19; 39; col. 12, lines 7-15)
    - aggregates (accumulating) claim pharmaceutical data and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of

pharmacy dispensing drug, and identity of doctor prescribing drug; and col. 3, lines 55-col. 4, line 27; Figure 3)

- causes the aggregated costs to be displayed (Figures 18-19)

Pack-Harris discloses the system as disclosed above, but does not expressly disclose providing pharmacy benefits formulary information.

Mayaud discloses a system and method for receiving pharmacy benefits formulary information. (col. 13, lines 49-61; col. 14, lines 10-19) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits. As suggested by Mayaud, one would have been motivated to include this feature to encourage better formulary prescription compliance and reduce health-care costs. (col. 13, lines 49-61)

Pack-Harris and Mayaud disclose the system as explained above, but does not expressly disclose:

- calculates out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information;
- aggregates the out-of-pocket costs, sponsor costs, and total pharmaceutical benefits dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, identity of pharmacy dispensing drug, and identity of doctor prescribing drug; and

- causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

Lencki et al discloses a method and system which:

- calculates out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; (Figure 22B-E; par. 89-91; 118,127)
- aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed; and (Figure 22B-E; par. 89-91; 118,127)
- causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits. (Figure 22B-E; par. 89-91; 118,127)

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/ method of Pack-Harris and Mayaud in combination with the teachings of Lencki. As suggested by Lencki, one would have been motivated to include these features to provide a catalyst for shared responsibility for quality/cost decisions around a benefits package. (par. 89, 91)

[claim 15] Pack-Harris discloses a server as recited in claim 14, wherein the selected drugs are drugs previously dispensed to a patient. (Figures 8 and 32; col. 6, lines 37-54)
[claim 16] Pack-Harris discloses a server as recited in claim 14, wherein the alternative

drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 17] Pack-Harris discloses a server wherein the benefits plan structure information (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives)) and the formulary information relate to a multi-tier benefits plan.

[claim 18] Pack-Harris discloses a server as recited in claim wherein the expenses associated and the expenses associated with the alternative drugs includes co-payment information and total cost information. (col. 5, lines 35-59; Figure 33)

[claim 23] Pack Harris discloses a server wherein the alternative drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 24] Pack –Harris discloses a server, wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 25] Pack-Harris discloses a server as recited in claim 14 further comprising means for entering proposed changes to any of the claim information, the benefit plan structure information, and the formulary information and displaying model data based on the proposed changes. (Figure 1; col. 3, lines 10-45; lines 55-col. 7, line 4)

[claim 26] Pack-Harris discloses a server as recited in claim 25, wherein the proposed changes comprise any of changes to co-payment amounts, changes to co-payment levels, and changes drugs dispensed. (col. 4, lines 33-67)

[claim 27] Pack-Harris teaches a pharmacy benefits management method comprising the steps of.

[claim 14] Pack-Harris discloses a pharmacy benefits management system comprising:

- receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; (col. 3, lines 10-34)
- receiving pharmacy benefits price information relating to drugs in various classes;
- receiving pharmacy benefits plan structure information including deductible information and co-payment information stored therein to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan;
- calculating total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information; (Figures 18-19; 39; col. 12, lines 7-15)
- aggregating (accumulating) claim pharmaceutical data and total costs of the drugs dispensed to patients based upon at least one of identity of drug

dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug; and col. 3, lines 55-col. 4, line 27; Figure 3)

- causing the aggregated costs to be displayed (Figures 18-19)

Pack-Harris discloses the system as disclosed above, but does not expressly disclose providing pharmacy benefits formulary information.

Mayaud discloses a system and method for receiving pharmacy benefits formulary information. (col. 13, lines 49-61; col. 14, lines 10-19) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits. As suggested by Mayaud, one would have been motivated to include this feature to encourage better formulary prescription compliance and reduce health-care costs. (col. 13, lines 49-61)

Pack-Harris and Mayaud disclose the system as explained above, but does not expressly disclose:

- calculating out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information;
- aggregating the out-of-pocket costs, sponsor costs, and total pharmaceutical benefits dispensed to patients based upon at least one of identity of drug

dispensed, type of drug dispensed, identity of pharmacy dispensing drug, and identity of doctor prescribing drug; and

- causing the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

Lencki et al discloses a method and system for:

- calculating out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; (Figure 22B-E; par. 89-91; 118,127)
- aggregating the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed; and (Figure 22B-E; par. 89-91; 118,127)
- causing the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits. (Figure 22B-E; par. 89-91; 118,127)

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/ method of Pack-Harris and Mayaud in combination with the teachings of Lencki. As suggested by Lencki, one would have been motivated to include these features to provide a catalyst for shared responsibility for quality/cost decisions around a benefits package. (par. 89, 91)

[claim 28] Pack-Harris teaches a method wherein the drugs dispensed to the patients in said calculating step are drugs previously dispensed to a patient indicated by the date the selected drugs were dispensed (Figures 8,24, and 32; col. 6, lines 37-54)

[claim 29] Pack-Harris, Mayaud and Lencki in combination disclose the system as explained in the rejection of claim 27 above. Furthermore, Pack-Harris teaches a method, wherein the alternative drugs are therapeutic alternatives with respect to the drugs dispensed to patients in said calculating cost step. (See Pack-Harris: Figure 4 (brand vs. generic))

[claim 30] Pack-Harris and Mayaud in combination teach a method wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 31] Pack-Harris teaches a method which includes costs for alternative drugs/therapeutic alternatives with respect to the drugs dispensed to patients in said calculating cost step. (See Pack-Harris Figure 4 (brand vs. generic)) Pack-Harris and Mayaud disclose the system as explained above, but does not expressly disclose calculating out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information.

Lencki et al discloses a method and system for calculating out-of-pocket costs, sponsor costs, and based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; (Figure 22B-E; par. 89-91; 118,127). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/ method of Pack-Harris and Mayaud in combination with the teachings of Lencki. As suggested by Lencki, one would have been motivated to include these features to provide a catalyst for shared responsibility for quality/cost decisions around a benefits package. (par. 89, 91)

[claim 36-37] The limitations of claims 36 and 37 are substantially similar to those of claim 27, and as such are addressed by the limitations of claim 27.

[claim 38] Pack-Harris and Mayaud in combination disclose a method further comprising the step of permitting entry of proposed changes to any of the claim information, the benefit plan structure information, and the formulary information; (col. 3, line 55-col. 4, line 67) and displaying model data based on the proposed changes. (Figure 3, col. 5, lines 35-67)

[claim 39] Pack-Harris discloses a method wherein the changes include the rejection, wherein the proposed changes comprise any of changes to co-payment amounts, changes to co-payment levels, and changes to drugs dispensed. (Figure 26; 38)

[claim 49] The limitations of claim 49 are substantially addressed by the rejection of claim 27. Furthermore Lencki discloses a method further comprising displaying aggregate out-of- pocket costs and sponsor costs to the sponsor of prescription benefits. (par. 254; 273-275) At the time of the Applicant's invention, it would have been obvious to modify the method of Pack-Harris and Mayaud with Lencki for the reasons provided in claim 27.

[claim 50] Pack-Harris discloses a method comprising: receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; (col. 3, lines 10-34)

As per the recitation of "a second set of claim information from a second pharmacy benefits server, the second set of claim information relating to pharmacy benefits claims processed by a second claims processing facility, and the second set of claim information including identification of drugs dispensed to patients," the courts have broadly held that the duplication of parts/ elements is obvious. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). As such, these changes do not present a patentable distinction over the applied prior art of record.

[claim 51] Pack-Harris teaches a method which includes costs for alternative drugs/therapeutic alternatives with respect to the drugs dispensed to patients in said calculating cost step. (See Pack-Harris: Figure 4 (brand vs. generic)) Pack-Harris and

Mayaud disclose the system as explained above, but does not expressly disclose calculating out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information.

Lencki et al discloses a method and system for calculating out-of-pocket costs, sponsor costs, and based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; (Figure 22B-E; par. 89-91; 118,127). At the time of time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/ method of Pack-Harris and Mayaud in combination with the teachings of Lencki. As suggested by Lencki, one would have been motivated to include these features to provide a catalyst for shared responsibility for quality/cost decisions around a benefits package. (par. 89,91)

[claim 52] The limitations of claims 52 are substantially similar to those of claim 27, and as such are addressed by the limitations of claim 27.

[claim 53] Pack -Harris discloses a pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients. (col. 3, lines 10-34)

As per the recitation of " a second pharmacy benefits means for receiving a second set of claim information, the second set of claim information relating to pharmacy benefits claims processed by a second claims processing facility, and the second set of claim information including identification of drugs dispensed to patients" the courts have broadly held that the duplication of parts/ elements is obvious. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). As such, these changes do not present a patentable distinction over the applied prior art of record.

[claim 54] Pack-Harris, Mayaud and Lencki in combination disclose the system as explained in the rejection of claims 14 and 53. Furthermore, Pack-Harris teaches a method, wherein the alternative drugs are therapeutic alternatives with respect to the drugs dispensed to patients in said calculating cost step. (See Pack-Harris Figure 4 (brand vs. generic))

[claim 55] Pack-Harris teaches system which includes costs for alternative drugs/therapeutic alternatives with respect to the drugs dispensed to patients in said calculating cost step. (See Pack-Harris Figure 4 (brand vs. generic)) Pack-Harris and Mayaud disclose the system as explained above, but does not expressly disclose calculating out-of-pocket costs, and sponsor costs, based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received pharmacy benefits plan structure, and the received price information.

Lencki et al discloses a method and system for calculating out-of-pocket costs, sponsor costs, and based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; (Figure 22B-E; par. 89-91; 118,127). At the time of time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/ method of Pack-Harris and Mayaud in combination with the teachings of Lencki. As suggested by Lencki, one would have been motivated to include these features to provide a catalyst for shared responsibility for quality/cost decisions around a benefits package. (par. 89,91)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626